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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,005

07/08/2003

Chip Maxson

0008

1031

43699 7590 04/08/2008

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EXAMINER

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ART UNIT

PAPER NUMBER

2157

MAIL DATE

DELIVERY MODE

04/08/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/616,005

Filing Date: July 08, 2003

Appellant(s): MAXSON ET AL.

Stewart J. Womack (Reg. No. 45,230)

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 11, 2008 appealing from the Office action mailed July 25, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,039,697	Bayles	5-2006
20020138291	Vaidyanathan	9-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant discloses "a reseller program for

allowing a plurality of Customers to register one or more domain names via a Registrar...” For the claimed invention to be statutory, it has to be embedded in computer readable medium.

The new amendment did not overcome the previous rejection. Applicant failed to show that the reseller program is “embodied in machine readable medium”.

For purpose of prior art rejection, Examiner will construe claim 1-10 as “a reseller program embodied in a machine readable medium for allowing a plurality of Customers to register one or more domain names via a Registrar”

2. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-17 and 20 are rejected under 35 U.S.C. 102(e) as being unpatentable over Bayles U.S. 7,039,697.

Bayles teaches the invention as claimed including registry-integrated Internet domain name acquisition system (see abstract).

As to claims 1, 6, 10 and 14, Bayles teaches a reseller program embodied in a machine readable medium and a process for allowing a plurality of Customers to register one or more domain names via a Registrar web site, comprising:

A) means for accepting a plurality of Resellers into a reseller program, wherein each Reseller has at least one reseller web site (column 6, lines 26-28);

B) means for creating a registrar web site for registering domain names with an appropriate Registry web site (figure 2);

C) means for allowing a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site (column 5, lines 29-46; column 6, lines 26-28);

D) means for collecting a fee from each Reseller web site that registers a domain name for a Customer via the registrar web site (column 6, lines 32-33; column 5, lines 29-46).

As to claim 2, Bayles teaches the reseller program and the process of claim 1, wherein the reseller web site has the ability to communicate with the registrar web site or the reseller web site includes Internet links to the registrar web site (figure 2)

As to claims 3, 8, 12, 13, 16 and 17, Bayles teaches the reseller program and the

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process of claims 1, 6, 10 and 14, wherein the reseller web sites communicate with the registrar web site via an application program interface protocol (column 6, lines 57-67; figure 1).

As to claim 4, Bayles teaches the reseller program of claim 1, wherein the actions by one of the plurality of Resellers include creating a link to the registrar web site from another web site (figure 1; column 5, lines 37-46).

As to claims 5, 7, 11 and 15, Bayles teaches the reseller program and the process of claims 1, 6, 10 and 14, further including means to register domain names via a proxy service, wherein proxy contact information is made publicly available while the Customer receives legal rights in the domain name (column 5, lines 32-36).

As to claim 20, Bayles teaches the process of claim 14, further including the steps of:

the customer linking from the reseller web site to the registrar web site; and after registering the domain name, linking from the registrar web site back to the reseller web site (figure 2).

4. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles U.S. 7,039,697 in view of Vaidyanathan et al. U.S. 20020138291 (referred to hereafter as Vaid).

Bayles teaches the invention substantially as claimed including registry-integrated Internet domain name acquisition system (see abstract).

As to claim 18, Bayles teaches the reseller program of claim 14.

Bayles fails to teach explicitly receiving electronic payments from the registrar based on activities of their associated customers.

However, Vaid teaches receiving electronic payments from the registrar based on activities of their associated customers (page 2, [0019]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bayles in view of Vaid to provide the administration web site offering the option to the resellers to receive electronic payments from the registrar based on activities of their associated customers. One would be motivated to do so to allow paperless transaction.

As to claim 19, Bayles teaches the reseller program of claim 14.

Bayles fails to teach explicitly displaying a report showing commission payments during selected time periods.

However, Vaid teaches displaying a report showing commission payments during selected time periods (page 1, [0009]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bayles in view of Vaid to provide the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods. One would be motivated to do so to allow efficient tracking of a reseller commission.

(10) Response to Argument

Appellant's arguments filed on 01/11/08 have been fully considered but they are not persuasive.

(A) On page 6, Appellant argues with respect to the 35 USC 101 rejection that Examiner has misinterpreted the meaning of the phrase “reseller program”. Appellant argues that the word “program” is used in the specification and in the claims in the sense of an organized club or group of individuals with a common purpose or goal.

In regards to point (A), examiner respectfully disagrees.

“a group of individuals allowing a plurality of customers to register one or more domain names via a registrar web site...” does not fall under a statutory category of invention and is non-statutory subject matter.

(B) On pages 7-8, Appellant argues that Bayles does not disclose limitation (C) of claims 1 and 10.

In regards to point (B), examiner respectfully disagrees.

Column 5, lines 29-46, Bayles discloses any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site (i.e. the same as “allowing a **reseller** web site or a plurality of **reseller** web sites to register one or more domain names for one or more customers via the registrar web site”)...

(C) On page 9, Appellant argues that Examiner’s quote in Bayles does not actually provide the monitor and acquire services and thus does not functionally

correspond to "registrar...domain names...via the registrar web site" from limitation C) in claim 1, and limitation C) in claim 10.

In regards to point (C), examiner respectfully disagrees.

Such argued limitation is neither in claims 1 or 10.

(D) On page 11, Appellant argues that the OA does not point out where in Bayles that claims 6 and 14 are taught.

In regards to point (D), examiner respectfully disagrees.

Column 5, lines 29-46, Bayles discloses any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site (i.e. the same as "the administrator web site (i.e. "registrar" in Bayles) allowing Resellers to enter the reseller program"). Customers can sign up to have the status of a desired name monitored and the name acquired or re-acquired automatically (i.e. "allowing each Reseller to customize the registrar web site for the Reseller's Customers").

(F) On page 12, Appellant argues that the purpose of Bayles and the purpose of Vaid are so different that there is no reasonable expectation of success in their combination.

In regards to the point (F), Examiner respectfully disagrees.

In response to “not a reasonable expectation of success in the combination of Bayles and Vaid”, Examiner is pointing out to Appellants that Both Bayles and Vaid inventions are in the same field of endeavor, and both of them are trying to solve the same invention. One of ordinary skill in the art would make adjustment to Bayles and Vaid reference to come up with this teaching.

(G) On pages 13-14, Appellant argues that in claim 18, the motivation provided by the Examiner to combine Bayles and Vaid is defective, and there is no motivation to combine.

In regards to the point (G), Examiner respectfully disagrees.

In response to applicant's argument that the motivation provided by the Examiner to combine Bayles and Vaid is defective, and there is no motivation to combine, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, One would be motivated to do so to allow paperless transaction to save time and money.

(H) On page 15, Appellant argues that in claim 19, the motivation provided by the Examiner to combine Bayles and Vaidyanathan is defective, and there is no motivation to combine.

In regards to the point (H), Examiner respectfully disagrees.

In response to applicant's argument that the motivation provided by the Examiner to combine Bayles and Vaid is defective, and there is no motivation to combine, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, One would be motivated to do so to allow efficient tracking of a reseller commission.

(I) On page 15, Appellant argues that neither Bayles nor Vaid disclose the limitation "to display a report showing commission payments during selected time periods" as recited in claim 19.

In regards to the point (I), Examiner respectfully disagrees.

Paragraph [0009], Vaid discloses ...if the second user downloads the particular file from the third party website, then the first user is paid the reseller commission set for the file...In such disclosure, Vaid teaches explicitly "commission payments" and "the selected time period (i.e. the time the second user downloads the particular file

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from the third party website). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bayles in view of Vaid to provide the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods. One would be motivated to do so to allow efficient tracking of a reseller commission.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is respectfully submitted that the rejection should be sustained.

Respectfully Submitted,

/El Hadji M Sall/

Examiner, Art Unit 2157

March 25, 2008

Conferees:

/Ario Etienne/

Supervisory Patent Examiner, Art Unit 2157

/Salad Abdullahi/

Primary Examiner, Art Unit 2157